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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,979	12/22/2000	Manoel Tenorio	020431.0748	8474

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Christopher W. Kennerly  
Baker Botts L.L.P.  
2001 Ross Lane, 6th Floor  
Dallas, TX 75201

EXAMINER
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SNAPP, SANDRA S

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/745,979

**Applicant(s)**

TENORIO, MANOEL

**Examiner**

Sandra Snapp

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2000.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-28 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 22 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

The Abstract is objected to because it is too long, it exceeds the 150 word limit.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9, 12, 14, 19, 22 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-9 and 19 are indefinite because they are directed to a “system” however there is claim language in the body of the claims that is directed to both an apparatus and a method. Therefore it is unclear to the Examiner exactly what the Applicant is claiming, a method or an apparatus, clarification is required.

Claims 3, 11 and 22 are indefinite because it is unclear exactly what “a substantially fungible item” is.

Claims 5, 14 and 24 are indefinite because the phrase “as a difference between historical prices of the target and reference items” is confusing. Does the Applicant mean a difference between the historical and current price of the target, and a difference between the historical and

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current price of the reference item? Or does the Applicant mean the difference between the historical price of the target and the historical price of the reference item?

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10-18 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 10-18 are non-statutory because the “software” claimed does not meet the requirements for computer readable mediums under the statute. Currently, the Patent Office has taken the position that data must satisfy a two-part test: 1) the code must be embodied or saved in a computer readable medium, and 2) that it be computer executable. Claims 10-18 fail the second prong of the test.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5-8, 10-12, 14-17, 20-22 and 24-27 are rejected under 35 U.S.C. 102(b) as being anticipated by the Reuhl et al. patent (US 5,873,069).

The Reuhl reference discloses a system, and associated software, for generating market pricing information for a non-fungible item, comprising:

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One or more databases containing and means for storing (col. 3, lines 40-47):

Historical pricing information for at least one reference item (col. 3, lines 40-47),

Historical pricing information for at least one non-fungible target item (col. 3, lines 40-47), and

Market pricing information for at least the reference item (col. 3, lines 40-47), and

A pricing engine operable to and means that (col. 4, lines 7-19):

Determine a pricing differential between the target item and the reference item, the pricing differential reflecting the historical pricing information for the target and reference items (col. 4, lines 7-19),

Access the market pricing information for the reference item (col. 4, lines 7-19), and

Apply the pricing differential to the market pricing information for the reference item to generate market pricing information for the target item (col. 4, lines 7-48) (Claims 1, 10, 19 and 20);

The market pricing information for the reference item comprises a substantially real-time current market price for the reference item (col. 4, lines 7-19), and

The market pricing information for the target item is generated in the form of a substantially real-time current market price quote for the target item for communication to a market participant (col. 4, lines 7-48) (Claims 2, 11 and 21);

The reference item is a substantially fungible item that serves as a proxy for price elasticity in at least a portion of a market that includes the target and reference items (col. 4, lines 7-48) (Claims 3, 12 and 22);

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The pricing engine computes the pricing differential in a manner selected from the group consisting of:

As a difference between historical prices of the target and reference items, and

As a percentage of the historical price of the reference item (col. 4, lines 7-48) (Claims 5, 14 and 24);

The pricing engine accesses a previously computed pricing differential from among a collection of such pricing differentials to determine the pricing differential that is applied (col. 4, lines 7-19) (Claims 6, 15 and 25);

The target item is selected from the group consisting of:

A part, component, product, or other tangible item, a service, real property, and a contract or other legal instrument (col. 3, lines 1-17) (Claims 7, 16 and 26); and

The target item is made more fungible, with improved liquidity, through generation of the market pricing information for the target item (col. 4, lines 7-48) (claims 8, 17 and 27).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 13 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Reuhl patent as described above, and further in view of the Foley patent (US 5,249,120).

The Reuhl patent discloses all the elements of the present invention, as stated above, except for:

The reference item is a fungible item that serves as a proxy for at least one indicator of price for the target item, the indicator being selected from the group consisting of cost per unit quantity of material used in creating the item, time or cost associated with one or more pieces of equipment used in creating the item, and time or cost associated with one or more persons involved in creating the item (Claims 4, 13 and 23).

The Foley patent teaches:

The reference item is a fungible item that serves as a proxy for at least one indicator of price for the target item, the indicator being selected from the group consisting of cost per unit quantity of material used in creating the item, time or cost associated with one or more pieces of equipment used in creating the item, and time or cost associated with one or more persons involved in creating the item (Foley - Abstract) (Claims 4, 13 and 23).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Reuhl patent with the teachings of the Foley patent so as to provide a more accurate and price reflective of the manufacturing costs associated with making the product.

Claims 9, 18 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Reuhl patent, as described above, and further in view of Nymeyer patent (US 3,581,072).

The Reuhl patent discloses all the elements of the claimed invention, as stated above, except for an electronic marketplace that is associated with the pricing engine and provides a

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bid-ask exchange with respect to a market that includes the target and reference items (Claims 9, 18 and 28).

The Nymeyer patent discloses an electronic marketplace that is associated with the pricing engine and provides a bid-ask exchange with respect to a market that includes the target and reference items (Nymeyer - Abstract) (Claims 9, 18 and 28).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the sales system of the Reuhl patent with the teachings of the Nymeyer patent so as to provide a different format with in which to sell the goods.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Foss, Brockwell, Long, Weiss, Korisch, Poland, Burak, Hyatt, Ricciardi, Lutnick, Narumo, Kitchen, Geraghty and Price patents and applications are directed to various types of electronic commerce and pricing systems.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600